

App. No. 09/271,008
Amdt. Dated 05/03/2004
Reply to Office Action of 02/02/2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed 02/02/2004. In the Office Action, the Examiner objected to the drawings and the specification and rejected claims 21 - 24 under 35 U.S.C. § 102, and claims 1 - 20 under 35 U.S.C. § 103. Reconsideration in light of the remarks made herein is respectfully requested.

Claims 1 - 24 remain in this application.

Double Patenting

2. Claims 1 - 20 were rejected under the judicially created doctrine of the obviousness-type double patenting of the claim of copending Application No. 09/271,011 and claims 1 - 20 as being unpatentable over claims 1-22 of copending Application No. 09/131,141. The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the instant application encompasses the claimed subject matters of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Therefore, Applicants acknowledge and offer submission of a terminal disclaimer to obviate the obviousness-type double patenting rejection upon allowance of the pending claims. Applicants respectfully request that the Examiner hold the obviousness-type double patenting rejection in abeyance until allowance of the pending claims.

Rejection Under 35 U.S.C. § 102

4. Claims 21 - 24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Simmons et al. (USP 6,192,028).

Applicants respectfully traverse the rejection and contend a *prima facie* case of anticipation has not been established. Figure 3 and column 7, lines 21 through column 10, line 12 of Simmons do not teach a receive buffer (34) from which data packets are promoted in an

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assigned order based on pointer values with priority given to pointer values in the first pointer value buffer (64,66). In Simmons, each data frame placed in the receive FIFO 64 has a header including at least a destination address, a source address and a type/length information. The rule checker, based on information in the header, determines where the frame packets will be cast, i.e., through which port the frame packet will be transmitted, using transmit FIFO 66. The header information does not contain any information regarding the order, priority, or the pointer values.

More importantly, Simmons teaches away from the invention by disclosing that the external rules checker "enables decision to be made in an order independent from the order in which the frames were received by the multiport switch." (Simmons, col. 6, lines 54-56). Simmons also teaches "random-based ordering in the decision queue". (Simmons, col. 6, lines 51-52). A random order implies that there is no order.

Accordingly, Applicants respectfully request the rejection under 35 U.S.C. § 102 be withdrawn.

Rejection Under 35 U.S.C. § 103

4. Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmons et al. (USP 6,192,028) in view of Frazier et al. (USP 5,784,559). Applicants respectfully traverse the rejection and contend that a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-124 (8th Ed., rev. 1, Feb. 2003). Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

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Neither Simmons nor Frazier discloses, inherently or expressly, or suggests one or more of the following: (1) receiving a plurality of indications denoting commencement of data packet transmission as recited in claims 1, 10, 16 and 19; (2) assigning pointer values to corresponding records based at least in part on a relative order as recited in claims 1, 10, 16 and 19; (3) the pointer value determining an order accordingly to complete reception of the frame in which the respective data packet is promoted as recited in claims 1, 10, 16 and 19; and/or (4) a receive buffer from which packets of data are promoted in an assigned order based on pointer values with priority given to pointer values in the first pointer value buffer as recited in claim 21.

The Office Action further states that Simmons, at col. 8, lines 7-33, discloses the disputed limitations (Office Action, page 12, third paragraph). However, as discussed in the previous response, Simmons merely disclose transferring the data frame from the receive FIFO to the external memory. (Simmons, col. 7, lines 62, 64). This is done merely based on the heading information not according to the complete reception of the frame. (Simmons, cols. 1-4). Furthermore, Simmons merely disclose determining each receive FIFO individually, not in an aggregated link including a plurality of links. (Simmons, col. 7, lines 44-46).

Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §103 be withdrawn.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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By


William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025